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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,262	09/11/2003	Takahiro Moro	00862.001703.2	3540
5514 7590 01/24/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER BAKER, CHARLOTTE M	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 01/24/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/659,262

Applicant(s)

MORO ET AL.

Examiner

Charlotte M. Baker

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-110 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 87-10 is/are allowed.
- 6) ☒ Claim(s) 102-110 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/768,579.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 102-110 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al. (5,006,895).

Regarding claim 102: The structural elements of apparatus claim 105 perform all of the steps of method claim 102. Thus, claim 102 is rejected for the same reasons discussed in the rejection of claim 105.

Regarding claim 103: Hashimoto et al. satisfy all the elements of claim 102. The structural elements of apparatus claim 106 perform all of the steps of method claim 103. Thus, claim 103 is rejected for the same reasons discussed in the rejection of claim 106.

Regarding claim 104: Hashimoto et al. satisfy all the elements of claim 102. The structural elements of apparatus claim 107 perform all of the steps of method claim 104. Thus, claim 104 is rejected for the same reasons discussed in the rejection of claim 107.

Regarding claim 105: Hashimoto et al. disclose a display unit (Fig. 3), configured to display a display window (Fig. 3) containing a setting value (selecting a book size/scanning size, col. 9, lines 1-10) of a first item (book size/scanning size) and a setting value of a second item (selected size of paper, col. 6, lines 18-24), and display a display window for accepting a user decision in a case where the user decision is required when the setting value of the second item is to be

changed (S29, Fig. 8B) in accordance with a change of the setting value of the first item (form a B5 to a A5, col. 9, lines 1-15, also see Figs. 8A and 8B repeat itself) (form Figs. 8A and 8B, if the book size changes and the magnification stays the same, most suitable paper size changes); and a change unit (Figs. 8A 8B are programs/routine of the host computer, col. 8, lines 45-46), configured to change the display of the setting value of the second item if the input decision of the user is a change (form a B5 to a A5, col. 9, lines 1-15, also see Figs. 8A and 8B repeat itself), and not changing the display of the setting value of the second item if the input decision of the user is not a change (not selected), and change the display of the setting value of the second item in a case where the user decision is not required (Figs. 8A and 8B are programs/routine of the host computer, column 8, lines 45-46) when the setting value of the second item is to be changed in accordance with a change of the setting value of the first item (also see changed, col. 11, line 39).

Regarding claim 106: Hashimoto et al. satisfy all the elements of claim 105. Hashimoto et al. further disclose wherein the first item includes a medium type (scanning medium, original, col. 9, lines 1-10) and the second item includes a paper supplying method (using a particular paper for printing, S29, Fig. 8B).

Regarding claim 107: Hashimoto et al. satisfy all the elements of claim 105. Hashimoto et al. further disclose wherein said change unit restores the display of the setting value of the first item to a setting value before changing and does not change the display of the setting value of the second item if the input decision of the user is not a change (the setting would not be changed is user does not use S31, Fig. 8B, in AMS mode), and said change unit changes

the display of the setting value of the second item if the input decision of the user is a change (Fig. 8B, S31).

Regarding claim 108: Arguments analogous to those stated in the rejection of claim 105 are applicable. A computer executable program stored in a computer-readable medium is inherently taught as evidenced by (Fig. 5) and various memories stored therein.

Regarding claim 109: Hashimoto et al. satisfy all the elements of claim 108. Arguments analogous to those stated in the rejection of claim 106 are applicable. A computer executable program stored in a computer-readable medium is inherently taught as evidenced by (Fig. 5) and various memories stored therein.

Regarding claim 110: Hashimoto et al. satisfy all the elements of claim 108. Arguments analogous to those stated in the rejection of claim 107 are applicable. A computer executable program stored in a computer-readable medium is inherently taught as evidenced by (Fig. 5) and various memories stored therein.

Allowable Subject Matter

3. Claims 87-101 are allowed. Please see Notice of Allowance dated 09/24/2007.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M. Baker whose telephone number is 571-272-7459. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CMB
CMB

KAWilliams

KIMBERLY WILLIAMS
PRIMARY PATENT EXAMINER